

REMARKS

In the Office Action¹, the Examiner:

- (1) rejected claims 1-30 under 35 U.S.C. § 101;
- (2) rejected claims 1, 2, 5-20, and 23-30 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application Publication No. 2004/0073467 to Heyns et al. (*Heyns*); and
- (2) rejected claims 3, 4, 21, and 22 under 35 U.S.C. § 103(a) as being obvious over *Heyns* in view of Official Notice.

Claims 1-30 are pending in this application, of which claims 1 and 16 are amended by this Amendment.

1. Rejection Under 35 U.S.C. § 101

The Office Action asserts that claims 1-30 are directed to non-statutory material because the “tools” and “modules” recited in claim 1 are allegedly “Functional Descriptive material per se” and because “Applicant allegedly provided “evidence that applicant intends the ‘output’ to include signals” in claims 1 and 16. See Office Action, pg. 3. Without conceding the propriety of the Office Action’s characterization of claims 1-30, claims 1 and 16 are amended to even more clearly be directed to statutory subject matter. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-30 under 35 U.S.C. § 101.

2. Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1, 2, 5-20, and 23-30

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

under 35 U.S.C. § 103(a) as being obvious over *Heyns*, and the rejection of claims 3, 4, 21, and 22 under 35 U.S.C. § 103(a) over *Heyns* in view of Official Notice. *Heyns* fails to teach or suggest each and every element of the claims.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.”

M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, *inter alia*, “a cost reduction strategy tool that receives the cost levers, said strategy tool including: a generation module that *generates a cost reduction strategy for one or more of the cost levers*; [and] a linking module that *correlates the cost reduction strategy with corresponding ones of the cost levers*” (emphasis added). Independent claim 16, although of different scope, recites similar elements.

The Office Action acknowledges that *Heyns* fails to teach or suggest the claimed generation module, linking module, implementation module, and output module, but asserts that it would have been obvious to modify *Heyns* to “maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.” See Office Action, pg. 5. The Office Action also alleges that it is not “inventive in terms of patentability to take one or more servers, in this case modules, which perform one or more tasks and add (or subtract) and addition number of modules to perform all or part of the same tasks by allocating the tasks between the various modules.” See Office Action, pg. 12. In other words, the Examiner alleges that *Heyns*’s VSIMT teaches all of the elements of claims 1 and 16, and thus separating *Heyns*’s VSIMT into separate modules would have been obvious to one of ordinary skill in the art.

Even if the Office Action’s characterization of it being obvious to use multiple modules to perform multiple functions instead of a single module to perform the multiple functions was correct, which Applicant does not concede, such a characterization is not applicable here at least because *Heyns*’s VSIMT does not perform the functions of the claimed modules.

Heyns's VSIMT is a tool that allows the user to see the impact on future cash flows of specific operating strategies (see paragraph [0068]), but the VSIMT does not generate a cost reduction strategy for one or more of the cost levers or correlate the cost reduction strategy with corresponding ones of the cost levers. For example, a user in *Heyns* can select a "strategy" from the list of available strategies which are pre-defined (i.e., not cost lever dependent) and cover "most business decisions that a user will want to test," such as, for example, an "Accounts Receivable Analysis." See paragraphs [0070]-[0071]; and Fig. 10. Subsequently, a user enters his or her own numbers into the model to test how the user's strategy impacts future cash flows. See *id.* Thus, even if *Heyns's* "strategy" could constitute the claimed "cost reduction strategy," which Applicant does not concede, *Heyns* still fails to teach or suggest generating "a cost reduction strategy for one or more of the cost levers" or correlating "the cost reduction strategy with corresponding ones of the cost levers" as recited in claim 1. Instead, *Heyns's* VSIMT simply tests user-created strategies that are unrelated to any received cost lever. This argument was presented in Applicant's previous response, but was not addressed in the outstanding Office Action.

Furthermore, the Office Action's motivation to modify *Heyns* to include these modules in order to "maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs" is a mere conclusory statement. For example, the Office Action has provided no indication as to how the inclusion of these modules would provide these alleged "excellent" benefits and reduce costs.

In view of the above, the Office Action has neither properly determined the scope

and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 1 and 16, as well as claims 2, 5-15, 17-20, and 23-30 depending therefrom.

Claims 3, 4, 21 and 22 depend from independent claims 1 or 16 and therefore include all of the elements recited therein. As discussed above, *Heyns* does not teach or suggest at least “a cost reduction strategy tool that receives the cost levers, said strategy tool including: a generation module that generates a cost reduction strategy for one or more of the cost levers; [and] a linking module that correlates the cost reduction strategy with corresponding ones of the cost levers,” as recited in claim 1, and similarly recited in claim 16.

Even if the Examiner’s “Official Notice” that it is old and well known in the art to “provide hyperlinks for documents” was proper, which Applicant does not concede, such Official Notice does not remedy the deficiencies of *Heyns*. Thus *Heyns* and the subject matter of the Official Notice, taken alone or in combination, fail to teach or suggest each and every element recited in independent claims 1 and 16, and required by dependent claims 3, 4, 21, and 22. Moreover, there is no motivation for one of ordinary skill in the art to modify the references to achieve the claimed combinations. Accordingly, the Final Office Action has not articulated a reason why the claims would be obvious to one of ordinary skill in the art. Thus, no *prima facie* case of obviousness has been established with respect to claims 3, 4, 21, and 22. Therefore, Applicant respectfully requests that

the Examiner withdraw the rejection of claims 3-4 and 21-22 under 35 U.S.C. § 103(a) over *Heyns* in view of Official Notice.

3. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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